

REMARKS**Consideration of Preliminary Amendment Filed September 15, 2003**

Applicants respectfully request entry of the preliminary amendment filed on September 15, 2003. The amendments made to the claims are included in the above claims. The Examiner had earlier indicated that this preliminary amendment would be considered and another Office Action would be issued based upon the preliminary amendment filed on September 15, 2003. However, no supplemental Office Action has been received.

Concurrently herewith applicants have petitioned to revive the application because technically the application was abandoned by failing to file a response to the Office Action mailed February 18, 2004.

Response to Objection of Specification

The disclosure was objected to by the Examiner because It appears that the application is no longer a divisional since new claims not originally in the patent were added. However, the original claims which were subject to the restriction requirement in the parent application remain pending in the present application and therefore applicants identification of this application as a divisional application is believed to be correct. The addition of new claims do not appear to be relevant to whether the present application is a divisional application. Absent a restriction requirement with respect to the pending claims, all of the now pending claims should be considered.

Response to Claim Objections

The Examiner advises that should claim 48 be found allowable, claim 49 will be objected to under 37 CFR §1.75 as being a substantial duplicate thereof. Applicants amendments to claim 49 have obviated the potential objection to claim 49.

Response to Claim Rejections Under 35 USC §112

Claims 17-20 are rejected by the Examiner under 35 USC §112, second paragraph, as being indefinite because claims 17-20 depend upon a cancelled claim. However, Applicants' preliminary amendment filed on September 15, 2003, addressed this issue, so the rejection should be moot.

Response to Claim Rejections Under 35 USC §102

Claims 17-22, 25-27, 30-33, 48 and 49 were rejected by the Examiner under 35 USC §102(b) as being anticipated by Okada (U.S. Pat. No. 4,638,802). However, these claims as previously amended and amended above call for the encapsulating assembly to encapsulate the severed specimen in its entirety. While Okada has an RF powered wire loop which extends out of the shaft, and has a sheath, there is no teaching of an assembly for encapsulating the entire severed specimen as called for in the pending claims.

Claims 17-28, 30-33, 48 and 49 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by Heaven et al. (U.S. Patent No. 5,611,803). However, Heaven also fails to teach encapsulating the entire severed specimen and pulling out the entire specimen intact.

Claims 17-22, 25-27, 30-33 and 48-49 are rejected by the Examiner under 35 USC §102(b) as being anticipated by Tihon et al. (U.S. Patent No. 5,415,656). Tihon

teaches cutting tissue with a loop of wire powered with RF but does not disclose separating a tissue specimen from a target site and encapsulating the entire severed specimen for removal.

Claims 17-28, 30-33, 48 and 49 are rejected by the Examiner under 35 USC §102(e) as being anticipated by McGuckin, Jr. (U.S. Patent No. 6,280,450). Specimen encapsulation with the McGuckin devices is longitudinal; whereas, encapsulation of the rejected claims is radial about the longitudinal axis, not along the longitudinal axis.

Conclusions

The pending claims as amended above are believed to be directed to patentable subject matter. Reconsideration and an early allowance are earnestly solicited.

Respectfully submitted,

By: 

Edward J. Lynch
Registration No. 24,422
Attorney for Applicants

DUANE MORRIS LLP
One Market
Spear Tower, Ste. 2000
San Francisco, CA 94105
Telephone: (415) 371-2200
Facsimile: (415) 371-2201
Direct Dial: (415) 371-2267